

REMARKS

By this Amendment, claim 1 is amended. Accordingly, claims 1, 9-13 and 19-21 are pending in this application. Reconsideration is respectfully requested.

Entry of the amendments is proper under 37 CFR §1.116 since the amendment: (a) places the application in condition for allowance (for the reasons discussed herein); (b) does not raise any new issue requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution); (c) does not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) places the application in better form for appeal, should an appeal be necessary. The amendment is necessary and was not earlier presented because it is made in response to arguments raised in the final rejection. Entry of the amendment is thus respectfully requested.

The Office Action rejects claims 19, 20 and 21 under 35 U.S.C. §102(e) over U.S. Patent No. 6,415,439 to Randell. This rejection is respectfully traversed.

Randell discloses a wireless communication protocol for communications between a controller 10 and one or more controlled devices 60. The controlled device 60 may be a doll, as shown for example in Figure 1. The doll shown in Fig. 1 of Randell is neither hand-held, nor is it a computing device, i.e., no central processing unit for performing computations is disclosed in the components of the doll shown in Figure 7. Nowhere in Randell is the controlled device 60 identified as a computer system.

The only computer systems disclosed in Randell are associated with the controller 10.

The controller 10 which controls the doll contains a processing unit as shown in Figure 2. Furthermore, column 11, lines 38-40 state: "Figure 2 illustrates an exemplary computer system for implementing the controller 10 in the duplex environment illustrated in Figure 1. The exemplary computer system includes a conventional personal computer."

The Office Action indicates that the claimed feature "a deformable piece integrally connected to a device having a CPU" and "a deformable piece integrally connected to a hand-held computing device" is disclosed in column 12, lines 1-4 and column 8, lines 25-29. These passages disclose that "aspects of the present invention are applicable to other computer system configurations. These other computer system configurations include but are not limited to hand-held devices" (emphasis added) and that "a user may enter commands and information into the personal computer through a keyboard." However, Applicants submit that the only computer systems disclosed in Randell are associated with the controller 10, not the controlled device 60. Therefore, this passage discloses only that the controller 10 may be embodied in other computer system configurations, such as hand-held devices. The passage does not disclose that the controlled device 60 may be embodied in a hand-held device.

The controller 10 of Randell is not integrally connected to the deformable piece. In fact, the controller 10 communicates with the controlled device only through wireless communications in Randell. Therefore, nowhere does Randell disclose the feature "a deformable piece integrally connected to a device having a CPU," as recited in claim 19, or "a deformable piece integrally connected to a hand-held computing device," as recited in claim 20, or "manipulating a deformable piece of malleable material integrally connected to a hand-held computing device," as recited in claim 21.

As set forth in Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Randell does not expressly or inherently disclose each and every feature of claims 19, 20 and 21. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. §102(e) be withdrawn.

The Office Action rejects claims 1, 9-11 and 13 under 35 U.S.C. §103(a) over Randell in view of U.S. Patent No. 5,299,125 to Baker et al. (hereinafter "Baker"). This rejection is respectfully traversed.

Applicants submit that absolutely no motivation exists in either reference to combine the references, and that one of ordinary skill in the art would not have been motivated to make the asserted combination at the time the invention was made. The Office Action asserts that "it would have been obvious to an artisan at the time of the invention to include Baker's method for inputting information wherein a first morpheme input and a second morpheme input are speech coefficients and form a sentence to Randell's method for inputting information wherein a first morpheme input and a second morpheme input are speech coefficients in order to provide users with an intelligent system that is able to combine morphemes and cipher to produce a syntactically and pragmatically correct sentence." However, Applicants submit that the Office Action has mischaracterized Randell. Nowhere in Randell are the first morpheme and second morpheme identified as "speech coefficients" and nowhere in Randell is any relationship between the first morpheme and the second morpheme disclosed, such that one of ordinary skill in the art would find it obvious that the morphemes be combined into a sentence. There is no indication in Randell, for example, that the doll is programmed to respond any differently to a sequence of morphemes, rather than to a plurality of isolated morphemes.

The Office Action has failed to establish a motivation for making the asserted combination, and the combination is therefore not *prima facie* obvious. Accordingly, Applicants submit that the rejection of claims 1, 9-11 and 13 under 35 U.S.C. §103(a) is improper and should be withdrawn.

In the response to arguments section of the Office Action, the Office Action identifies a keyboard and a mouse as being the deformable pieces. However, neither of these devices is

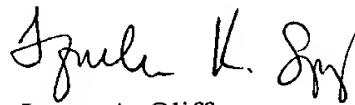
integrally connected to the device to which the first morpheme and the second morpheme are being input. Instead, they are connected by a cable or other means to the input/output interface of the controller 10, as shown in Fig. 2.

Furthermore, the response to arguments section fails to provide any further explanation or motivation for the asserted combination of Randell and Baker relied upon to reject claims 1, 9-11 and 13. Accordingly, Applicants respectfully request that the rejection of claims 1, 9-11 and 13 under 35 U.S.C. §103(a) be withdrawn.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 9-13 and 19-21 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Jaquelin K. Spong
Registration No. 52,241

JAO:JKS/scg

Date: April 26, 2004

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 24-0037</p>
